## REMARKS

In the November 3, 2004 Office Action, (1) Original claims 1 and 4 were rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (U.S. Patent 5,963,861) and (2) Original claims 2 and 3 were rejected under 35 U.S.C 103(a) as being obvious over Hanson (U.S. Patent No. 5,963,861) in view of Blumberg et al. (U.S. Patent Application No. 2004/0110515 A1). Original claims 5-8 were declared allowable. The Examiner is thanked for allowing Original claims 5-8.

### CLAIM AMENDMENTS

Claim 1- 4 have been currently amended and are fully supported by the Original disclosure. "Computer device" finds support on page 2, line 34 of the Original specification. "Global Positioning System" finds support on page 3, line 12 of the Original specification. "User input" finds support on page 4, line 15 of the Original specification. "The phone number look-up device" finds support on page 2, line 19 of the Original specification. "Based on location" finds support on page 2, line 22 of the Original specification.

### SECTION 102(B) REJECTIONS

Original claims 1 and 4 were rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (U.S. Patent 5,963,861).

Under 35 USC 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. See *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). There must be no difference between the claimed invention and the reference disclosure. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). Anticipation can be found only when the reference discloses exactly what is claimed. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985).

Applicants respectfully assert that current amended claim 1 is not anticipated by Hanson. As now amended, claim 1 is a method for wirelessly connecting a computer device to a server, the method comprising (1) generating location data related to the computer device; (2) wirelessly



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sending the location data to a phone number look-up device; (3) retrieving at least one phone number from the memory of the phone number look up device, and based on the location data; (4) wirelessly sending the retrieved at least one phone number to the mobile computer device; and (5) wirelessly connecting the mobile computer device to the server using the at least one phone number. Therefore, Hanson does not anticipate currently amended claim 1 unless each of these limitations identically appears in Hanson, which is not the case.

First, Hanson does not teach generating data related to the location of the computer device. In the instant amendment, the computer device itself determines its precise location. As described below in currently amended claims 2 and 3, this is via a global positioning system (GPS) or via user input. Hanson, on the other hand, teaches generating data related to the location of mobile phones using the location of base stations that mobile calls originate from as a proxy. "[W]hen a mobile terminal initiates a call to a dealer-location service, *an identification of the base station* through which the call is made ... is used to determine a business location of the dealer that is in the vicinity of the calling station." See Hanson (U.S. Patent 5,963,861) Col. 1 Lines 50-60 (emphasis added). Therefore, Hanson does not teach generating location data based on the computer device, but instead has to go to the server.

Second, Hanson does not teach wirelessly sending the location data to a phone number look-up device. In Hanson, the mobile computer device does not transmit location information to a phone number look-up device. In fact, the mobile computer device in Hanson does not store, retrieve, or even possess location information. Instead, the location data in Hanson is obtained from a base station identification. "When a mobile telephone initiates a call to the dealer-locator service, *a mobile telephone switching office (MTSO 41) identifies the one of a plurality of base stations* (20-23) through which the call is made." See Hanson (U.S. Patent 5,963,861) Abstract (emphasis added). "[A]n *identification of the base station* through which the call is made ... is used to determine a business location of the dealer that is in the vicinity of the calling station." See Hanson (U.S. Patent 5,963,861) Col. 1 Lines 50-60 (emphasis added).



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"[T]he arrangement *determines which one of the plurality of base stations* is presently communicating with the mobile communications station." See Hanson (U.S. Patent 5,963,861) Col. 2 Lines 5-10 (emphasis added). Thus, Hanson does not teach and is not enabling for the mobile computer device wirelessly sending location data to a phone number look-up device.

Every limitation must exactly and identically appear in a single prior art reference with no difference for it to anticipate the claim. See *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991); *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). Hanson does not teach (1) generating data related to the location of the mobile computer device using GPS or user input or (2) the mobile computer device wirelessly sending the location data to a phone number look-up device. Therefore, Applicant respectfully submits that Hanson does not anticipate the present invention because there are significant differences between the present invention and Hanson.

Furthermore, the limitations of the present invention that do not appear in Hanson are not obvious improvements. In *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* (1986), the Federal Circuit held that a single line in a prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness. Rather, a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Considered as a whole, Hanson teaches away from generating data related to the location of the mobile computer device using GPS or user input because it specifically teaches an alternative way of generating location data: determining the location of base stations. "When a mobile telephone initiates a call to the dealer-locator service, *a mobile telephone switching office (MTSO 41) identifies the one of a plurality of base stations* (20-23) through which the call is made." See Hanson (U.S. Patent No. 5,963,861) Abstract (emphasis added). "[A]n *identification of the base station* through which the call is made ... is used to determine a business location of the dealer that is in the vicinity of the calling station." See



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Hanson (U.S. Patent 5,963,861) Col. 1 Lines 50-60 (emphasis added). "[T]he arrangement *determines which one of the plurality of base stations* is presently communicating with the mobile communications station." See Hanson (U.S. Patent 5,963,861) Col. 2 Lines 5-10 (emphasis added). Second, Hanson expressly states that the base station method is used precisely because the location of the mobile computer device *itself* cannot be determined. "The user of the mobile communications station is thus informed of the whereabouts of, or is connected to, a business location of the service provider that is likely to be one of the closest, if not the closest, to the user at the present time, *even though the user is on the move wherefore the user's own geographical position cannot be determined....*" See Hanson (U.S. Patent No. 5,963,861) Col. 2 Lines 20-30 (emphasis added). Therefore, Hanson teaches away from generating data related to the location of the mobile computer device using GPS or user input because it specifically teaches an alternative way of generating location data to overcome the inability to determine the precise location of the mobile computer device itself.

Considered as a whole, Hanson also teaches away from the mobile computer device wirelessly sending the location data to a phone number look-up device. The court in Gurley held that ''A reference may be said to teach away when a person of ordinary skill, upon reading the reference, *would be discouraged* from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the *line of development flowing from the reference's disclosure is unlikely to be productive* of the result sought by the applicant. *In re Gurley*, 7 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994) (emphasis added). In the present case, Hanson teaches using base-stations to determine location data to overcome the inability to determine the precise location of the mobile computer device itself. Thus, under Hanson there is no location data available in the mobile computer device itself and *a fortiori* Hanson is incapable of the mobile computer device wirelessly sending location data that it does not possess. The absence of data to send in the



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mobile device of Hanson would certainly discourage a person of ordinary skill from sending data.

Claim 4 depends from claim 3 that in turn depends from claim 1. Claim 4 concerns user input, wherein the user input comprises (1) recording location information as spoken by a user and (2) generating location data by performing active speech recognition of the recorded location information.

First, Applicant respectfully submits that Hanson does not anticipate Claim 4 for the same reasons Hanson does not anticipate Claim 1 as set forth above.

Second, Hanson does not teach generating data related to the location of the computer device by recording location information as spoken by the user and generating location data by performing active speech recognition of the recorded location information. To begin, Hanson does not teach generating data related to the computer device using user input. Instead, as has been discussed above, Hanson teaches generating data related to the location of a mobile phone using base stations. "When a mobile telephone initiates a call to the dealer-locator service, *a mobile telephone switching office (MTSO 41) identifies the one of a plurality of base stations* (20-23) through which the call is made." See Hanson (U.S. Patent No. 5,963,861) Abstract (emphasis added). "[A]n *identification of the base station* through which the call is made ... is used to determine a business location of the dealer that is in the vicinity of the calling station." See Hanson (U.S. Patent No. 5,963,861) Col. 1 Lines 50-60 (emphasis added). "[T]he arrangement *determines which one of the plurality of base stations* is presently communicating with the mobile communications station." See Hanson (U.S. Patent No. 5,963,861) Col. 2 Lines 5-10 (emphasis added). Given that Hanson does not teach generating location data using user input, Hanson a fortiori does not teach generating location data using speech and voice recognition. In the November 3, 2004 Office Action, Claim 4 was rejected because "Hanson inherently teaches...generating location data by performing active speech recognition of the recorded location information (col. 4 lines 19-26, lines 49-56)." See November 3, 2004 Office



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Action, Page 3., Col. 4, lines 19-26 disclose the mobile device recording the service provider, or business establishment, that the user wishes to contact: "[The] response is either a touch-tone signal selecting an item from a menu, or a spoken name of the desired service provider (e.g., 'ATM machine', 'Luigi's pizza', 'service station', etc.)." See Hanson (U.S. Patent No. 5,963,861) Col. 2 Lines 19-26 (emphasis added). The present invention teaches generating data related to the location of the mobile computer device *by recording location information* as spoken by the user and *generating location data* by performing active speech recognition of the recorded location information. Although Hanson does teach recording of desired service providers, it does not teach recording location information and generating location data based thereon. Next, Col 4, lines 49-56 disclose audio feedback to the user of the requested service provider's address: "IP 43 receives the record 302, at step 438, and *reports the contents of that record's dealer location address entry 304 to the caller*, at step 440. Illustratively, IP 43 voices the record contents to the caller via conventional text-to-speech conversion. Alternatively, record 302 may contain a recorded speech file, in which case IP 43 *merely plays back record 302 to the caller*. The caller receives this information, at step 442, and becomes informed thereby of a geographically-proximate location of the desired service provider." See Hanson (U.S. Patent No. 5,963,861) Col. 2 Lines 49-56 (emphasis added). The present invention teaches generating data related to the location of the mobile computer device *by recording location information* as spoken by the user and *generating location data* by performing active speech recognition of the recorded location information. Although Hanson teaches audibly reporting the contents of the server response to the user, it does not teach recording location information as spoken by the user and generating location data based thereon.

Every limitation must exactly and identically appear in a single prior art reference with no difference for it to anticipate the claim. See *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991); *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). Applicant therefore



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respectfully submits that Hanson does not anticipate the present invention because Hanson does not teach recording location information as spoken by the user and generating location data based thereon.

Furthermore, generating data related to the location of the mobile computer device by recording location information as spoken by the user and generating location data by performing active speech recognition of the recorded location information is not an obvious limitation over Hanson. In *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* (1986), the Federal Circuit held that a single line in a prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness. Rather, a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Considering the reference as a whole, Hanson argues against and teaches away from generating data related to the location of the mobile computer device by recording location information as spoken by the user and generating location data by performing active speech recognition of the recorded location information. First, as discussed above, Hanson teaches away from the mobile computer device generating location data using user input because it specifically teaches an alternative way of generating location data: determining the location of base stations. "When a mobile telephone initiates a call to the dealer-locator service, *a mobile telephone switching office (MTSO 41) identifies the one of a plurality of base stations* (20-23) through which the call is made." See Hanson (U.S. Patent No. 5,963,861) Abstract (emphasis added). "[A]n *identification of the base station* through which the call is made ... is used to determine a business location of the dealer that is in the vicinity of the calling station." See Hanson (U.S. Patent No. 5,963,861) Col. 1 Lines 50-60 (emphasis added). "[T]he arrangement *determines which one of the plurality of base stations* is presently communicating with the mobile communications station." See Hanson (U.S. Patent 5,963,861) Col. 2 Lines 5-10 (emphasis added). Second, Hanson expressly states that the base station method is used



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precisely because the location of the mobile computer device *itself* cannot be determined. "The user of the mobile communications station is thus informed of the whereabouts of, or is connected to, a business location of the service provider that is likely to be one of the closest, if not the closest, to the user at the present time, *even though the user is on the move wherefore the user's own geographical position cannot be determined....*" See Hanson (U.S. Patent No. 5,963,861) Col. 2 Lines 20-30 (emphasis added). Therefore, Hanson teaches away from generating data related to the location of the mobile computer device using user input because it specifically teaches an alternative way of generating location data to overcome the inability to determine the precise location of the mobile computer device itself. Because Hanson teaches away from generating data related to the location of the mobile computer device using user input, it a fortiori teaches away from recording location information as spoken by the user and generating location data by performing active speech recognition of the recorded location information. Again, the court in Gurley held that "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, *would be discouraged* from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the *line of development flowing from the reference's disclosure is unlikely to be productive* of the result sought by the applicant. *In re Gurley*, 7 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994) (emphasis added). A person of ordinary skill, upon reading Hanson, would certainly be discouraged from recording user input of location given the fact that Hanson specifically teaches the generation of location data based upon base stations rather than user input.

Therefore, Applicants assert currently amended claims 1 - 4 are novel and non-obvious over Hanson for the reasons stated above and earnestly request reconsideration and movement towards allowance.



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## SECTION 103(A) REJECTIONS

Original claims 2 and 3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (U.S. Patent No. 5,963,861) in view of Blumberg et al. (U.S. Patent Application No. 2004/0110515A1). Original claims 2 and 3 concerned telematics, PDAs, and laptop computers.

Currently amended claims 2 and 3 now concern different specification subject matters from that claimed in Original claims 2 and 3. The new claimed subject matters concern sources of generating data related to the location of the computer device. The sources include GPS for currently amended claim 2 and user-selected in currently amended claim 3.

Due to the different subject matters now claimed in currently amended claims 2 and 3, applicants respectfully assert that obviousness based rejections on the prior subject matters of Original claims 2 and 3 no longer apply. Accordingly, applicants respectfully request reconsideration and movement towards allowance of currently amended claims 2 and 3.



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## CONCLUSION

Applicants respectfully request withdrawal of the rejections, allowance, and early passage of currently amended claims 1 - 4 through issuance. Again, the Examiner is thanked for allowing Original claims 5 - 8.

If the Examiner has any questions, the Examiner is invited to contact the Applicant's agent listed below.

Respectfully submitted,

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**MAIL CERTIFICATE**

I hereby certify that this communication is being deposited with the United States Postal Service via first class mail under 37 C.F.R. § 1.08 on the date indicated below addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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